

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 50-54 were present for examination. No claims are amended. No claims are cancelled. Therefore, claims 50-54 are present for examination, and claim 50 is the independent claim. Applicant respectfully requests reconsideration of this application.

The Office Action initially rejected claims 50-54 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Wallach U.S. 5,147,723 ("Wallach") and Safabash, U.S. 5,957,166 ("Safabash").

35 U.S.C. §103(a) Rejection, Wallach, Safabash

The Office Action initially rejected claims 50-54 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Wallach and Safabash. However, the Office Action has failed to establish a *prima facie* case of unpatentability in view of these references. For example, the office action has failed to show how the cited references teach each and every element of claim 50. Furthermore, the Office Action has failed to state a motivation for combining the two references. In addition, the Office Action has made summary conclusions in regard to the dependent claims without offering any support for those conclusions, such as citations from the references or indications that official notice was being made by the Examiner.

First, the Office action has failed to show how the cited references teach each and every element of claim 50. Claim 50 currently recites:

50. (original) A method of dispensing a substance comprising LCP, said method comprising:
mixing said substance in a first syringe;

transferring said substance from said first syringe to a second syringe, said second syringe having a volume size smaller than the volume size of said first syringe;
utilizing said second syringe to dispense said LCP.

The office action does not address at least the limitation of "said second syringe having a volume size smaller than the volume size of said first syringe." As noted in the specification, for example, at paragraphs 29-31 of Applicant's specification, the LCP can be transferred to a smaller syringe so as, for example, to facilitate dispensing LCP in small measurable quantities and in small testing containers. The Office Action does not address this limitation and the two cited references do not appear to teach this. In fact, the Safabash reference appears to teach that material is transferred from a smaller syringe (18) to a larger syringe (20) for dispensing by the larger syringe. The Wallach reference that the Office Action relies on appears to teach that material is exchanged between two syringes of equal volume -- namely two 25 ml syringes that are used to drive the mixture back and forth between one another. Thus, it appears that neither the Safabash nor the Wallach references teach that the syringe that does the dispensing is smaller than the syringe that initially contained the LCP.

Thus, the combination of Safabash and Wallach does not teach all the limitations of claim 50 because it fails to teach at least the element of "said second syringe having a volume size smaller than the volume size of said first syringe." Because the Office Action has failed to address each and every limitation of the claim and because the cited references also do not teach each and every element of the claim, the Office Action has failed to establish a *prima facie* case of unpatentability under 35 USC §103.

It should also be noted that in considering a rejection under 35 USC §103 that an examiner must determine whether the claimed subject matter as a whole would have been obvious in view of the prior art. One consideration in making such a determination is the determination of the problem by the inventors. Applicant was innovative in recognizing the

problem caused by the use of LCP in test conditions. Recognition of a problem is taken into account in determining obviousness, as has been noted by the courts.

Moreover, the conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. . . . The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem; and though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negative invention.

In re Bisley, 94 USPQ 80, 86-87 (C.C.P.A. 1952).

Similarly, in *Ex parte Hiyamizu* the Board of Patent Appeals and Interferences stated:

Under 35 U.S.C. 103 where the examiner has relied on the teachings of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. It is to be noted, however, that citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. . . . Furthermore, it is well settled that where the claimed invention solves a problem, the discovery of the source of the problem and its solution are considered to be part of the "invention as a whole" under 35 U.S.C. 103.

Ex parte Hiyamizu, 10 USPQ 2d 1393, 1394-95 (B.P.A.I. 1988)

The inventors recognized that it is difficult to prepare LCP in very small syringes due to the pressures required to move the highly viscous LCP back and forth between syringes. Yet, to be useful in some test situations, LCP requires dispensing in small and exact quantities that are benefited by the use of small syringes. The Safabash and Wallach references show no appreciation for this problem. In fact, they appear to teach away from a solution to the problem in view of the fact that material is transferred from a smaller syringe to a larger syringe

(Safabash) or between two syringes of equal size (Wallach). Thus, for this reason, as well, the claimed embodiment in claim 54 is non-obvious.

The office action also fails to establish a *prima facie* case of obviousness under 35 USC §103 in view of the fact that it fails to state any reason as to why one of ordinary skill in the art would combine the teachings of Safabash and Wallach. It is a well-established principle that an examiner must provide such a reason in order to combine references in a 35 USC §103 rejection. For example, in *C.R. Bard, Inc. v. M3 Sys., Inc.*, the Court of Appeals for the Federal Circuit stated:

The invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-52, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination).

C.R. Bard, Inc. v. M3 Sys., Inc., 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998)

The Office Action provided no such suggestion, teaching or motivation. Thus, it fails to establish a *prima facie* case of non-obviousness under 35 USC §103.

In addition, the Office Action has merely addressed the dependent claims by stating that they would be obvious without providing any support for those conclusions, such as citations from the references or indications that official notice was being made by the Examiner. Such bald assertions are not permitted. An examiner must supply some basis for a conclusion of obviousness either from a citation of a reference or a taking of official notice. For example, in *In re Ichihashi*, the Court of Appeals for the Federal Circuit stated:

No evidence, either of additional art, or supplementary evidence of what one of ordinary skill would have understood at the time the application was filed, was cited by

the board in support of this assertion. . . . Nowhere in the board's opinion are there any findings as to the level of ordinary skill in the relevant art, or any examples, either from the single prior art reference or otherwise of an implementation of a route table. . . . [T]here remains no indication in the record that one of ordinary skill would find any motivation in the prior art to place the route table/switch unit in the position specified by the claims, thus allowing a communication device to function with a single transmitting-receiving unit.

At oral argument, the solicitor conceded that there was nothing in the board's opinion or the record before this court to support such motivation, other than the bald assertion by the board that it would have been obvious. In the absence of some evidence of the level of ordinary skill, including evidence tending to show what one of such ordinary skill would be motivated to accomplish in view of the cited prior art, the board may not rest a *prima facie* case only on its own unsupported assertions.

In re Ichihashi, Civ. App. No. 93-1172, slip op. at 2-3 (Fed. Cir. Sept. 9, 1993) (unpublished)

To the extent that the Examiner does assert official notice in the future, and so as not to waive any rights, Applicant requests that the Examiner supply an affidavit under 37 C.F.R. 1.104(d)(2) in regard to any such assertion.

For at least these reasons, the rejection of claim 50 is respectfully traversed.

Claim 50 is believed to be in condition for allowance as written. Similarly, claims 51-54 are believed to be in condition for allowance for at least the same reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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